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EXAMINER	
BELIVEAU, SCOTT E	

ART UNIT	PAPER NUMBER
2614	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/693,288	JERDING ET AL.
	Examiner	Art Unit
	Scott Beliveau	2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-40 is/are pending in the application.

4a) Of the above claim(s) 29 and 36 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-28,30-35 and 37-40 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 20 October 2000 is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-28, 30-35, 37-40, drawn to a method for extending a media rental period, classified in class 725, subclass 58.

   II. Claims 29 and 36, drawn to drawn to a method for extending a media rental period based on available bandwidth, classified in class 725, subclass 95.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility in so far a user requesting an extension to a media rental period may be offered a non-contiguous alternative time. Invention I does not require the particulars pertaining to confirming bandwidth availability in conjunction with media rental extension. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Shelley Couturier on or around 17 September 2003 a provisional election was made without traverse to prosecute the invention of Group I,

claims 1-28, 30-35, 37-40. Affirmation of this election must be made by applicant in replying to this Office action. Claims 29 and 36 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

6. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 3-4, 6-7, 10-13, 15-19, 21-22, 24-28, 30-35, and 37-40 of this application. While the provisional application discloses the general concept of facilitating the extension of a rental, the examiner cannot find support for the claimed particulars pertaining to the selection of price, the means of selection, user alerts, and client/server composition in the provisional application.

Drawings

7. The drawings are objected to because the label for element "109" (Figure 5) should be amended to read "You've Got Mail" and the label for element "104" (Figure 6) should be amended to read " . . . if you plan on watching the movie . . . ". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

8. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 91 (Page 13, Line 17) and 173 (Page 13, Line 24). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

9. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include reference sign(s) not mentioned in the description: 107 (Figure 5) and 89 (Figure 4). A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, 2, 4-9, 11, 13-17, 19-24, 30-31, and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Goode et al. (US Pat no. 6,166,730).

Claim 1 is rejected wherein Figure 1 of the Goode et al. reference illustrates a "method" for providing "media" to a user via an "interactive media services client device" [118] that is "coupled" [110] to a "programmable media services server device" [106] (Col 3, Lines 10-17). During the media ordering process, the embodiment "receives user input identifying a media rental" wherein the rental has an associated "defined access duration" of 24 hours or two times the length of the title (Col 14, Lines 11-25). The user may subsequently "request that the access duration be extended" wherein upon completion of the order the "access duration is extended" accordingly (Col 14, Line 55 – Col 15, Line 22).

Claim 11 is rejected as aforementioned in claim 1 wherein the "client device" [118] comprises a "processor" [512] and "memory" [520] that is operable to "extend the access duration for a media rental in response to user input" (Col 13, Lines 40-53).

Claim 17 is rejected as aforementioned in claim 1 wherein the "server device" [106] comprises a "processor" [400] and "memory" [402] that is operable to "extend the access duration for a media rental in response to user input" (Col 15, Lines 8-33).

Claim 2 is rejected wherein the user may be "provided with pricing information related to the time period extension" (Col 4, Lines 33-46, 63 – Col 5, Line 9; Col 14, Line 63 – Col 15, Line 2).

Claims 4, 13, and 19 are rejected wherein the "price charged for extending the time period" is "computed by an algorithm stored in the memory" or software instructions within the server device [116] (Col 4, Lines 40-46).

Claims 5, 14, and 20 are rejected wherein the "media rental" is a "movie" (Col 17, Lines 55-67).

Claims 6, 15, and 21 are rejected wherein the "user input" may be received via a "remote control device" [120].

Claims 7-8, 16, and 22 are rejected wherein the "display device" [122] is a "television" (Col 4, Lines 27-31) and the "user selects the media rental and requests the access period extension by selecting options displayed" though an on-screen electronic programming guide (Col 13, Line 65 – Col 14, Lines 10, 63-66).

Claim 9 is rejected wherein the method further involves "presenting the user with the media rental" [750].

Claim 23 is rejected wherein Figure 1 of the Goode et al. reference illustrates a "method" for providing "media" to a user via an "interactive media services client device" [118] that is "coupled" [110] to a "programmable media services server device" [106] (Col 3, Lines 10-17). During the media ordering process, the embodiment may "receive user input" to "request that the access duration to a media presentation be extended" wherein upon completion of the order the "access duration is extended" accordingly (Col 14, Line 55 – Col 15, Line 22).

Claim 30 is rejected as aforementioned in claim 23 wherein the "client device" [118] comprises "memory" [520] and computer executable "logic" that is operable to "cause an access duration for a media presentation to be extended in response to user input requesting an extension for said access duration" (Col 13, Lines 40-53).

In consideration of claims 24 and 31, the Goode et al. reference explicitly incorporates a detailed description of the navigator presented in the Gordon et al. (US Pat No. 6,208,335) reference (Col 11, Lines 12-15). As illustrated in Figure 17 of the Gordon et al. reference the embodiment may "provide said user with information regarding a media presentation remaining rental time". This screen may be presented "prior" to or after the ordering of a media presentation.

Claim 37 is rejected as aforementioned in claim 23 wherein the "system" [100] comprises a "memory" [402] and computer implemented "logic" that is operable to "cause an access duration for a media presentation to be extended in response to user input requesting an extension for said access duration" (Col 15, Lines 8-33).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person -- having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the

time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 3, 10, 12, 18, 25-28, 32-35, and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goode et al. (US Pat no. 6,166,730).

In consideration of claims 3, 12, and 18, as aforementioned, the Goode et al. reference discloses that pricing is determined based on a requested resource (Col 4, Lines 40-46) and that the purchase may include terms including "extending the access duration" as entered by a "system operator via a control menu" (Col 14, Lines 63-66). While the reference does not explicitly disclose that the "price charged for extending the time period" depends on the terms of purchase, the examiner takes OFFICIAL NOTICE that it is a well known practice in the art to bill consumers different prices for a resource based on the particular selected options. Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the embodiment, if necessary, to charge different prices for media based on the "system operator" selecting an extended viewing period for the purpose of providing a means by which the service provider may obtain additional revenue in exchange for an extended reservation or additional usage of system bandwidth.

In consideration of claim 10, the Goode et al. reference discloses that the embodiment stores a "viewing time" [624] and a "use time" [623], either collectively or separately interpreted as an "access duration" time. The reference discloses that the embodiment is operable to determine if there is "insufficient rental time remaining for viewing a remainder of the media rental", that the presentation will not be terminated until the user terminates the presentation or the movie concludes (Col 16, Lines 42-59). Accordingly, a user who

temporarily or mistakenly leaves a movie presentation in progress whose "access duration" has expired would unexpectedly be unable to return to the movie as it would no longer be available as an active media presentation as illustrated in Figure 17 of the Gordon et al. reference. Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to "alert" the user that there is "insufficient rental time remaining" prior to the exiting of the presentation for the purpose of providing the user with a user friendly reminder that they will have to reorder the presentation should they exit the presentation. Such a reminder may advantageously reduce the number of dissatisfied customers and number of account credits (Gordon et al.: Figure 13).

With respect to the "alert" being performed "prior to the step of receiving user input requesting that the access duration be extended", the claim language does not preclude that the "extension" process may not be met through the simple reordering of the program. Accordingly, the limitation would be met wherein a user initially orders a media presentation for 24 hours and subsequently reorders or "extends" the "access duration" of the media presentation for another 24 hours or repeated viewing. Alternatively, the Goode et al. reference is not limiting with respect to the ordering process necessarily being performed so as to renew a session. The concept of "renewing" rentals is known in the art. For example, libraries in Fairfax County, VA allow readers to "renew" their book or video "rentals" so that they may keep them longer. Accordingly, it would have been obvious to one having ordinary skill in the art to provide the user, in conjunction with the alert, with the option to reorder/renew so as to "extend" the "access duration" of the program for the purpose of proving a simpler means to enable the viewer to increase or decrease the "access duration" of

an existing program such that they are not required to re-traverse the list of media titles, place a new order for the program, and then fast-forward to the previous point in the movie.

In consideration of claims 25 and 32, while the Goode et al. reference discloses that the "remaining playing time" [624] may be stored and utilized in conjunction determining whether or not to close a session (Col 15, Lines 34-42). The reference does not explicitly disclose nor preclude the display of this information to the subscriber. Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to "provide said user with information regarding a media presentation remaining playing time" for the purpose of reminding the user as to remaining viewing time [624] currently available for the selected program. This information would be particularly valuable in a multiple set-top environment (Figure 10) given that the viewer who orders the presentation may not realize that another viewer within the household has watched the media presentation, hence creating the situation wherein the viewer who ordered the may find it ending unexpectedly or unable to watch the movie a second time.

In consideration claims 26, 33, and 38, the Goode et al. reference suggests that the "active program list" as illustrated in Figure 17 of Gordon et al. may comprise information regarding "said remaining rental time" that is "displayed concurrently with said media presentation" (Goode et al.: Col 18, Lines 21-33). Neither reference explicitly discloses nor precludes the display of additional information such as the "remaining playing time" as referenced in claims 25 and 32. As aforementioned, the Goode et al. reference discloses that it stores information pertaining to both "remaining rental time" and "remaining playing time". Accordingly, it would have been obvious to one having ordinary skill in the art at the

time of the invention to modify the "active program list" so as to display both "remaining rental time" and "remaining playing time" for the purpose of informing viewers in a multiple set-top box household as to the remaining "rental" and "playing" time such that they are not surprised by a disruption in service as a result of the viewing of the requested media presentation by another party in the household.

Claims 27-28, 34-35, and 39-40 are rejected as aforementioned in 10. As to the composition of the alert, it would have been an obvious matter of design choice to utilize a "graphical alert, a textual alert, or an audio alert", since applicant has not disclosed that the particular format of the "alert" solves any states problem or is for any particular purpose and it appears that the invention would perform equally well with any method of alerting the user as to the expiration of the "access duration".

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Dunn et al. (US Pat No. 5,861,906) reference discloses an interactive entertainment network system with configurable rental periods.
- The Adivi et al. (WO 01/20907) reference discloses a video distribution system that facilitates the extension of rental periods. This reference does not currently qualify as prior art under 35 U.S.C. 102 because it does not designate the US.

- The LaJoie et al. (US Pat No. 5,850,218) reference discloses a system and method for providing a full service cable television system. Figures 33-34 illustrate the display of elapsed time in conjunction with a NVOD program.
- The Haddad (US Pat No. 5,555,441) reference discloses a video distribution center wherein subscriber requests may specify a variable time allowance interval within which a requested program may be delivered.
- The Javed (US Pub. No. 2001/0036271) reference discloses a method for facilitating the extension of rental periods for downloaded video materials. This reference explicitly incorporates the priority documents of the Adivi et al. reference in their entirety.
- The Nomura et al. (US Pub No. 2002/0078176) reference discloses a video-on-demand system wherein viewers may "renew" video rentals. This reference does not currently qualify as prior art under 35 U.S.C. 102.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

SEB
September 25, 2003

JOHN MILLER
SUPERVISORY PATENT EXAMINER
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